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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/542,109
Filing Date: March 31, 2000
Appellant(s): KIGHT ET AL.

MAILED

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GROUP 3600

Alfred A. Stadnicki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 08/29/2003

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that each of the claims 36, 38, 39, 40, 42, 43, 44, 46, 47, 48, 50, 51, 52, 54, 55, 56, 58, 59, 60, and 61 stands and falls alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,321,672	Braun	3-1982
5,220,501	Lawlor et al.	6-1993
4,270,042	Case	5-1981

Paschal , Jan; " New Edition of Rand McNally Bankers Directory Available";
Journal Record; Oklahoma City; Feb 11, 1987, extracted on the Internet from
<http://proquest.umi.com> on 01/27/2003, hereinafter referred to as Paschal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:
The grounds of rejection are reproduced below from the final Office Action and are
provided here for the convenience of both Appellant and the Board of Patent Appeals:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. (US Patent 4,321,672), hereinafter, referred to as Braun in view of Paschal, Jan, "New edition of Rand McNally Bankers directory available", Journal Record; Oklahoma City; Okla.; Feb 11, 1987, extracted on the Internet from <http://proquest.umi.com> on 01/27/2003, hereinafter, referred to as Paschal.

With regards to claims 36, and 38-39, Braun teaches a method for processing consumer banking information, comprising the steps of storing a plurality of routing numbers associated with a plurality of financial institutions, receiving and entering a routing number associated with a financial institution at which a consumer maintains a deposit account and comparing the received routing number to the stored plurality of routing numbers to verify accuracy of received routing number and if the routing number does not correspond to one of the stored plurality of routing numbers it is rejected (see at least col.11, line 50-col.12, line 8, col.1lines 5-. Note: ABA account number includes the routing number; see FIG.7 and col.16, lines 61-66. Braun discloses receiving and entering a routing number from a negotiable unit record, and this routing number is compared with the already stored routing numbers in a data processor of a financial institution and if the received routing number does not correspond to the stored routing number it is rejected and if it matches it is accepted.).

Braun discloses that the routing numbers of the financial institutions are stored under a customer's central account in a data processor of a financial institution. Brian does not disclose that the stored plurality routing numbers of financial institutions are stored together in a designated financial institution file. However, in the same field of endeavor of storing routing numbers, Paschal teaches storing plurality of routing numbers together in a designated financial institution file (see at least Paschal, page 1, last paragraph-page 2, 2nd paragraph). Paschal teaches that Rand McNally's directory of routing numbers has been the only source for storing routing numbers together of the US banks/financial institutions since 1911. Rand McNally has been continuously publishing this directory and updating it with changes in the routing numbers of the US banks/financial institutions. In view of Paschal's teaching about Rand McNally's directory for routing numbers; it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun to include Rand McNally's directory of both active and retired routing numbers to verify the accuracy of the routing number received from a customer. Doing so would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is active or retired or incorrect routing number.

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7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braun/Paschal in view of Lawlor and further in view of Case (US Patent 4,270,042).

Braun/Paschal teaches a method for processing consumer-banking information as disclosed in claim 36 and analyzed above. Braun/Paschal further teaches bill payment via universal funds transfer instruments (see at least Braun, col.16, lines 22-26). Braun/Paschal does not teach receiving a request to pay a bill associated with a merchant on behalf of the consumer, determining if the consumer financial institution accepts electronic fund transfer and generating an instruction to pay the bill by electronic fund transfer from the customer deposit account. However, Lawlor teaches receiving a request to pay a bill associated with a merchant on behalf of the consumer, determining if the consumer financial institution accepts electronic fund transfer and generating an instruction to pay the bill by electronic fund transfer from the customer deposit account (see at least, col.10, line 66-col.11, line 65, "... To use bill paying features....using an ATM network, the service provider pays customer bills by first debiting the user's account....Funds are transferred through the ATM network....Payments are preferably processed immediately electronically, where feasible.....Otherwise bills are paid by paper check). As disclosed in col.11, lines 55-60, Lawlor determines if the payment can be done electronically and if not then it is processed via paper check. In view of Lawlor, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun/Paschal to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network and generate payment instructions via electronic funds transfer if feasible. Doing so would benefit consumers to implement bill payments electronically from home and benefit payees by cutting down their processing costs, float, offering more predictable cash flow as explicitly disclosed in Lawlor (see col.11, line 61-col.12, line 3).

Lawlor does not disclose that the feasibility of electronic funds transfer is determined based on the verified routing number. However, Case, in the field of electronic funds transfer system, teaches to determine if the consumer's financial institution accepts electronic fund transfers based on the verified routing number (see at least, FIG.3, 3A, col.4, line 61-col.5, line 2,"...a punch out element 37, which designates that the subsequent handling I to be by EFT..... The five spaces occupied by the blocks 59, 60 and the punch out 37 will be referred to hereinafter as "ABA standards optional spaces", col.5, line 54-col.6, line 26, "... the draft, with the punch-out 37 plusmakes it possible to handle all subsequent steps in settlement of the transaction to be carried out on an EFT basis.....", col.7, lines 13-56,col.9, lines 13-34. Note: Here, Case teaches explicitly the use of an ABA space allocation 37-punch out-to denote if an electronic funds transfer is feasible or not and this ABA space location 37 corresponds to the part of routing number). In view of Case, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun/Paschal/Lawlor to include the feature of determining if electronic funds transfer can be made based on the verified routing numbers. Doing so would help the method of Braun/Paschal/Lawlor to determine if the payment is feasible by electronic funds transfer or via paper as suggested in both Lawlor (see at least col.11, lines 55-60) and Case (col.5, line 54-col.6, line 9).

8. Claims 42-43, 44, 46-48, 50-51, 52-56, 58-59, and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun/Paschal in view of Lawlor and further in view of Case (US Patent 4,270,042).

With regards to method claims 42-43 and 60-61 their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

With regards to system claims 44, 46-48, and 50-51, their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

With regards to article of manufacture claims 52-56, and 58-59, their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

(11) Response to Argument

1. The Appellant has argued that, " The Examiner has failed to establish a prima facie case (see pages 11-17). The examiner does not agree for reasons given below.

The Appellant argues on pages 13-15, concerning claim 36 that according to Braun, each financial institution only verifies its own account numbers, and therefore only its own routing number implying that Braun does not need storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institution file.

The examiner does not agree for the following reasons:

This argument has no relevance to the recited limitations in claim 36. Recited limitations in claim are directed to storing a plurality of routing numbers for a plurality of financial institutions and comparing a received routing number to the stored plurality of routing numbers to verify the accuracy of the received routing number. Braun discloses these limitations, i.e. the customer can have multiple accounts and those accounts can belong to one or more financial institutions (see at least, col.12, lines 58-66, "*..If the customer has multiple accounts, linkage indicators are resident in the central computer memory of the customer's financial institution. These linkage indicators interrelate the checking account number on the negotiable unit record*

being used to all other pertinent accounts that are also held by the customer. This facilitates transfer of funds between accounts by the processor 19 or 23 upon the insertion of a single negotiable unit record without additional account information". Note: it would be obvious to one of ordinary skill in the Banking and check processing field, that when a customer has multiple checking accounts they could be with different banks/financial institutions and different routing numbers and as such when verifying the routing numbers all those routing numbers would be stored in the system. Further, there will be more than one customer who will be using ATMs and ATSS and different customers could have checking account numbers with different financial institutions having different routing numbers. This inherently means that a plurality of routing numbers are stored and while verifying the routing numbers they are compared with the plurality of stored routing numbers. Regarding the use of multiple checking account numbers see also col.3, lines 61-68, " *the same system enables the incorporation of many options, such as the usage of multiple accounts, the logging and tallying of information for a merchant, the supplying of additional information as to account and credit status, and cooperation with a central switching and processing center for interaction with other financial institutions* ", and col.20, line 30-59, " *... Multiple accounts may be provided for by the following type of arrangement. After the customer has caused his ABA account number and PIN to be transmitted to the data processor 23 of the customer's financial institution, the data processor 23 transmits also, a message containing the numbers of all accounts of a given type for those cases where the customer has more than one account of a given type, or alternatively, the numbers of all the accounts held by the customer. That information is routed to the microprocessor 46 and incorporated into an account listing display program which causes a display on the video display screen 31 of account numbers of all accounts held by the customer. In this display each account number is preceded by a number. For example, the display could contain entries such as "3. Savings Acct. 484 502 163" or "5. Checking Acct. 217 482 19."* The customer would then be instructed to enter on the keyboard 29 the number preceding the account to be affected followed by depression of the "Enter" button and the transaction selector button corresponding to the desired type of transaction. If the transaction involves two accounts the customer is instructed to enter also the number preceding the second account to be affected, followed by depression of the "Enter" button, before pressing the appropriate transaction selector button ".

In view of the above, it is obvious that Braun teaches storing a plurality of routing numbers associated with the plurality of financial institutions and after receiving a

routing number it is compared with the stored plurality of routing numbers to verify its correctness and as submitted in the final rejection on pages 7 and 8 and also reproduced above.

The Appellant further argues (on page 14), concerning claim 36 that " *Also as acknowledged by the Examiner, Braun fails to disclose (i) the required storage of plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number* ". This is incorrect. Examiner acknowledged only " Brian does not disclose that the stored plurality routing numbers of financial institutions are stored together in a designated financial institution file ", see final rejection, page 8 and also reproduced above.

Further, with reference to the Appellant's arguments (pages 13-15) concerning claim 36, that there is no prima facie case to combine Braun and Paschal, the Examiner does not agree for the following reasons:

As analyzed above Braun does store a plurality of routing numbers but does not expressly teach they all are store in one designated file as "financial institution file" recited in the claimed limitation. However, in the same filed of banking, Paschal teaches that a designated "financial institution file" storing plurality of routing numbers exists and this fact is old and very well known to a person of an ordinary skill in the art of banking that ABA (American Banking Association) stores the routing numbers of financial institutions in Rand McNally Bankers Directory, see Paschal, pages 1- 2, " *The*

1987 ABA Key to Routing Numbers ", a directory of American Bankers Association numbers used to route checks is now available.....This directory is the only source for both active and retired routing numbers. It has been published continuously since 1911, the year that RandMcNally became the official number agent for the American Bankers". Having established that the knowledge of storing of plurality of routing numbers of plurality of financial institutions was existing in the prior art it would be obvious to a person of an ordinary skill in the banking and check processing field that financial institutions and other users would use "*ABA Key to Routing Numbers*" disclosed in Paschal to note the changes such as the new additions of routing numbers and also the retired routing numbers to update their individual records. See the following court-cases which support the above analysis:

In re Fine, 5 USPQ2d 1596 (CA FC 1988). The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that **knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references.". *In re Bozek*, 163 USPQ 545 (CCPA 1969) "Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from **common knowledge and common sense** of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'" *In re Bode, Nolan, Baker, Mathias, and Pfaender*, 193 USPQ 12 (CCPA 1977) "Every patent application and reference relies to some extent on knowledge of persons skilled in art to **complement that disclosed**, in order that it be 35

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U.S.C. 112 "enabling," and to satisfy requirements of reference under 35 U.S.C. 102."

In re Shepard, 138 USPQ 148 (CCPA 1963) "In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the **reasonable inferences** which one skilled in the art would logically draw therefrom." *In re Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CA FC 1989) A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including **non-preferred embodiments**. *In re Bozek*, 163 USPQ 545 (CCPA 1969) "Test for obviousness is not whether features of one reference may be **bodily incorporated** into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

In view of Paschal, It would have been obvious to a person of an ordinary skill in the banking and check processing field, to have modified Braun at the time of the Appellant's invention to incorporate the feature of storing all the routing numbers of all the financial institutions in a one designated file such as "*ABA Key to Routing Numbers*" as demonstrated in Paschal. Doing so would further help to the efficiency of verifying the routing numbers presented by the users when those routing numbers belong to the group of newly added numbers or retired numbers so that they can be approved or rejected respectively.

The Appellant argues, (pages 20-22), regarding claim 40, that since the debiting

of the consumer's account is always performed via the ATM, which is an electronic transfer, there is no need in Lawlor of a determination whether or not the consumer's financial institution accepts electronic funds transfer. With due respect, the examiner declines to agree to this interpretation for following reasons:

Lawlor explicitly teaches making determination if payments can be implemented via electronic funds transfer and if not an alternative method such as paper check, see at least col.11, lines 55-65, "*Payments are preferably processed immediately electronically, where feasible, either immediately or "warehoused" for a short time for transmittal with other user payments to a single payee. Otherwise, bills are paid by paper check. Electronic payments can be processed through an Automated Clearing House (ACH) system, (e.g., Federal Reserve) directly to payee (point-to-point), or to the payee's bank (directly or indirectly through an ATM network or other remittance channel)*". Note: Both Lawlor and the Appellant suggest the same solution to the problem that is on determination if the funds cannot be transferred electronically then the payment is effected via paper, see the Appellant's disclosure, page 11, lines 14-16). *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967) the court decision was, "Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they **do not teach or suggest exactly why this should be done**, other than to obtain the expected superior beneficial results." . *In re Wiseman* , 201 USPQ 658 (CCPA 1979) Mere recognition of **latent properties** in the prior art does not render nonobvious an otherwise known invention. *In re Bozek*, 163 USPQ 545 (CCPA 1969) "Reference disclosure must be evaluated for **all that it fairly suggests** and not only for what is indicated as preferred." *Merck & Co.*

Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843 (CA FC 1989) A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including **non-preferred embodiments**. *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CA FC 1989) A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including **non-preferred embodiments**.

The Appellant further argues, see pages 16-17 concerning claim 40, that the reference Case does not suggest making a determination if the consumer financial institution accepts electronic fund transfers based on the verified routing numbers. These arguments attack the Case reference individually. In response to the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejection is based on combinations of references. See *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co., Inc.*, 231 USPQ 375 (CA FC 1986).

It was already analyzed in claim 36 that Braun in view of Paschal verifies the routing numbers for their correctness. It was further analyzed above that Braun/Paschal in further view of Lawlor make determination if payments can be implemented via electronic funds transfer. The Examiner acknowledged in the final action that Braun/Paschal in view of Lawlor did not disclose that the feasibility of electronic funds transfer is determined based on the verified routing number (Note: the verified routing number here refers to the same routing number recited in claim 36 which is already verified as analyzed in claim 1). The Examiner took support of the prior art reference

Case, see the final office action, pages 9-10 and reproduced above, because it explicitly discloses that the routing numbers of financial institutions do determine if electronic funds transfers can be implemented by the financial institutions (see at least Case, col.4, lines 61-63, *".. In the next space, also optionally available under said standards, is a punch-out element 37, which designates that the subsequent handling is to be by EFT "*). In view of Case, it would have been obvious to have modified Braun/Paschal in view of Lawlor to incorporate the Case feature of determining if the financial institution accepts electronic funds transfer from its routing numbers to provide an efficient solution to the problems recited in Braun/Paschal in view of Lawlor as applied to claim 40 (see at least Lawlor col.11, lines 55-60, *" Payments are preferably processed immediately electronically, where feasible, either immediately or "warehoused" for a short time for transmittal with other user payments to a single payee. Otherwise bills are paid by paper check "*) to enable the system to efficiently and quickly decide to send payments electronically or by paper check.

With regards to the Appellant's arguments on page 17 that, *" Claims 42-44, 46-48, and 58-61 stand rejected on the same basis as claim 40.....for at least the reasons discussed above "*, the examiner disagrees as rejection of claims 42-44, 46-48, and 58-61 is maintained as for the claim 40 analyzed above.

2. The Appellant has argued that, *" There is no motivation to combine the art as proposed by the examiner "(see pages 18-22). The examiner does not agree for*

reasons given below.

The Appellant remarks (on page 18), concerning claim 36 that “ *Hence, as acknowledged by the Examiner, Braun fails to disclose (i) the required storage of plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number of claim 36* “. This is incorrect. The Examiner acknowledged only “ Brian does not discloses that the stored plurality routing numbers of financial institutions are stored together in a designated financial institution file “, see final rejection, page 8 and also reproduced above.

The Appellant argues on pages 18-20, concerning claim 36 that according to Braun, each financial institution only verifies its own account numbers, and therefore only its own routing number implying that Braun does not need storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institution file. The examiner does not agree for the same reasons as analyzed above in (1) above.

Further, with reference to the Appellant’s arguments (pages 18-20) concerning claim 36, that there is no motivation to combine Braun and Paschal, the Examiner does not agree for the same reasons as explained and analyzed above in (1) above..

The Appellant argues, (pages 20-21), regarding claim 40, that since the debiting of the consumer’s account is always performed via the ATM, which is an electronic transfer, there is no need in Lawlor of a determination whether or not the consumer’s

financial institution accepts electronic funds transfer. With due respect the examiner declines to respect this interpretation for same reasons as analyzed above in (1).

The Appellant further argues, see pages 21-22, concerning claim 40, that the reference Case does not suggest making a determination if the consumer financial institution accepts electronic fund transfers based on the verified routing numbers. These arguments attack the Case reference individually. In response to the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejection is based on combinations of references. See *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co., Inc.*, 231 USPQ 375 (CA FC 1986).

It was already analyzed in claim 36 that Braun in view of Paschal verifies the routing numbers for their correctness. It was further analyzed above that Braun/Paschal in further view of Lawlor make determination if payments can be implemented via electronic funds transfer. The Examiner acknowledged in the final action that Braun/Paschal in view of Lawlor did not disclose that the feasibility of electronic funds transfer is determined based on the verified routing number (Note: the verified routing number here refers to the same routing number recited in claim 36 which is already verified as analyzed in claim 1). The Examiner took support of the prior art reference Case, see the final office action, pages 9-10 and reproduced above, because it explicitly discloses that the routing numbers of financial institutions do determine if electronic funds transfers can be implemented by the financial institutions (see at least Case, col.4, lines 61-63, "... In the next space, also optionally available under said standards, is a punch-out element

37, which designates that the subsequent handling is to be by EFT ".). In view of Case, it would have been obvious to have modified Braun/Paschal in view of Lawlor to incorporate the Case feature of determining if the financial institution accepts electronic funds transfer from its routing numbers to provide an efficient solution to the problems recited in Braun/Paschal in view of Lawlor as applied to claim 40 (see at least Lawlor col.11, lines 55-60, " *Payments are preferably processed immediately electronically, where feasible, either immediately or "warehoused" for a short time for transmittal with other user payments to a single payee. Otherwise bills are paid by paper check* ") to enable the system to efficiently and quickly decide to send payments electronically or by paper check.

With regards to the Appellant's arguments on page 22 that, " *Claims 42-44, 46-48, and 58-61 stand rejected on the same basis as the claims discussed above. Accordingly, it is respectfully submitted that the Examiner has likewise rejected these claims on the basis of a proposed combination of are which is unmotivated*", the examiner disagrees as rejection of claims 42-44, 46-48, and 58-61 is maintained on the same basis as discussed and analyzed for claims 36 and 40 above.

3. The Appellant has argued that, " The applied references fail to suggest the claimed invention "(see pages 22-30). The examiner does not agree for reasons given below.

The Appellant remarks (on pages 24-25), concerning claim 36 that " *Furthermore, as acknowledged by the Examiner, Braun fails to disclose (i) the required storage of plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number of claim 36* ". This is incorrect. The Examiner acknowledged only " Brian does not discloses that the stored plurality routing numbers of financial institutions are stored together in a designated financial institution file ", see final rejection, page 8 and also reproduced above.

The Appellant argues on pages 24-25, that according to Braun, each financial institution only verifies its own account numbers, and therefore only its own routing number implying that Braun does not need storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institution file. The examiner does not agree for the same reasons as analyzed above in (1) above.

Further, with reference to the Appellant's arguments (pages 24-25), that there is no motivation to combine Braun and Paschal, the Examiner does not agree for the same reasons as explained and analyzed above in (1) above..

The Appellant argues, (pages 25-26), regarding claim 40, that since the debiting of the consumer's account is always performed via the ATM, which is an electronic transfer, there is no need in Lawlor of a determination whether or not the consumer's financial institution accepts electronic funds transfer. With due respect the examiner declines to respect this interpretation for same reasons as analyzed above in (1).

The Appellant further argues, see pages 25-26, that the reference Case does not suggest making a determination if the consumer financial institution accepts electronic

fund transfers based on the verified routing numbers. These arguments attack the Case reference individually. In response to the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejection is based on combinations of references. See *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co., Inc.*, 231 USPQ 375 (CA FC 1986).

It was already analyzed in claim 36 that Braun in view of Paschal verifies the routing numbers for their correctness. It was further analyzed above that Braun/Paschal in further view of Lawlor make determination if payments can be implemented via electronic funds transfer. The Examiner acknowledged in the final action that Braun/Paschal in view of Lawlor did not disclose that the feasibility of electronic funds transfer is determined based on the verified routing number (Note: the verified routing number here refers to the same routing number recited in claim 36 which is already verified as analyzed in claim 1). The Examiner took support of the prior art reference Case, see the final office action, pages 9-10 and reproduced above, because it explicitly discloses that the routing numbers of financial institutions do determine if electronic funds transfers can be implemented by the financial institutions (see at least Case, col.4, lines 61-63, "... In the next space, also optionally available under said standards, is a punch-out element 37, which designates that the subsequent handling is to be by EFT ".). In view of Case, it would have been obvious to have modified Braun/Paschal in view of Lawlor to incorporate the Case feature of determining if the financial institution accepts electronic funds transfer from its routing numbers to provide an efficient solution to the problems recited in

Braun/Paschal in view of Lawlor as applied to claim 40 (see at least Lawlor col.11, lines 55-60, "*Payments are preferably processed immediately electronically, where feasible, either immediately or "warehoused" for a short time for transmittal with other user payments to a single payee. Otherwise bills are paid by paper check*") to enable the system to efficiently and quickly decide to send payments electronically or by paper check.

In view of the above discussions and the analysis, the Examiner does not agree to the Appellant's statement, on page 22, " Therefore, it is respectfully submitted that the applied prior art lacks any teaching or suggestions of the following claimed features " followed by the list of limitations from claims 36, 38, 39, 40, 42, 43, 44, 46, 47, 48, 50, 51, 52, 53, 54, 55, 56, 58, 59, 60, 61 on pages 26-30. For the above reasons the rejections of all these listed claimed features is maintained as submitted in the final office action.


4. Lastly, the Appellant has argued that, " The rejection is based on either an improper hindsight reconstruction of the invention based on the applications own teachings or on pure speculation "(see page 30). The examiner does not agree for reasons given below.

The Examiner has considered only that knowledge, disclosures and teachings which were disclosed in the prior art and whatever it was within the level of ordinary skill in the art at the time of the Appellant's invention as discussed in detail above. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), "Any judgment on obviousness is in a sense

necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure**, reconstruction is proper". As analyzed and discussed in detail above, objective and explicit teachings in the prior art plus the knowledge generally available to one of ordinary skill in the art at the time of the Appellant's invention have been used to combine references. *In re Fine*, 5 USPQ2d 1596 (CA FC 1988) The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art **or that knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references.". *In re Bozek*, 163 USPQ 545 (CCPA 1969) "Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from **common knowledge and common sense** of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference ".

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

Art Unit: 3625

YCG

November 17, 2003

Conferees



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